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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON DC 20036

In re Application of :
Klaus Schelberger et al :
Serial No.: 09/868,515 : PETITION DECISION
Filed: June 18, 2001 :
Attorney Docket No.: OZ 0050/49651 :

This is in response to applicants' petition under 37 CFR 1.181, filed December 30, 2002 (Certificate of Mailing dated December 23, 2002), requesting reversal of the examiner's decision not to enter the amendments filed under 37 CFR 1.116 submitted November 25, 2002.

A review of the file history shows that this application is the National Phase filing of PCT/EP99/09803 and was accepted as complete on June 18, 2001, and contained, as amended, claims 1-10. The assigned examiner issued a first Office action to applicants on October 24, 2001, setting forth a restriction/election of species requirement based on morpholine or piperidine compounds (Formulas Ia-d) and benzamidoxime compounds (Formula II) and required an election of a single species from each group. The examiner argued that neither group possessed a common core. Applicants replied on January 20, 2002 (Certificate of Mailing dated November 26, 2001), by making several amendments to the specification to correct typographical errors, amending claims 2-10 and adding claim 11 and electing Formula Ia (morpholine) and II.79, and presenting a declaration under 37 CFR 1.132. No traversal of the restriction requirement was made.

A new examiner mailed a new Office action to applicants on April 23, 2002, making the restriction requirement Final and withdrawing claims 6 and 11 as being drawn to non-elected species. The examiner also stated that there is no allowable or generic linking claim. The examiner rejected claims 1-5 and 7-10 under 35 U.S.C. 112, first paragraph, as lacking

description in the specification and under 35 U.S.C. 112, second paragraph, as indefinite, and under 35 U.S.C. 103(a) as unpatentable over Schwalge et al in view of Kasahara et al.

Applicants replied on July 2, 2002 (Certificate of Mailing dated June 26, 2002), by amending claims 1, 3, 10 and 11 and replying to each of the rejections. The examiner mailed a Final Office action to applicants on August 27, 2002, setting a three month shortened statutory period for reply. The examiner indicated that claim 6 was drawn to the elected species and included it with the other claims under examination (although the summary sheet does not so indicate), but not claim 11 as it was considered to be indefinite. The examiner also agreed that unity of invention was not lacking between claims 6 and 11 and the other claims. The examiner rejected claims 1-10 under 35 U.S.C. 112, first paragraph, for lack of enablement and also under 35 U.S.C. 103(a) as unpatentable over Schwalge et al in view of Kasahara et al.

Applicants replied on December 2, 2002 (Certificate of Mailing dated November 25, 2002), with a proposed amendment canceling claims 2-8 and 11 and amending claim 1, and presenting arguments for entry and to overcome the rejections. The examiner denied entry of the amendment based on the amendment not placing the application in better condition for appeal. On December 30, 2002 (Certificate of Mailing dated December 23, 2002), applicants filed a Notice of Appeal and this petition.

DISCUSSION

Applicants argue firstly that the lack of unity holding is improper and that all claims should be considered as a single invention. It is noted that claims 1-9 and later added claim 11 are all directed to a fungicidal mixture (composition) and all depend directly or indirectly on claim 1. Claim 10 is directed to a method of controlling fungi using the composition of claim 1. According to PCT rules applicants are correct that the claims do not lack unity and should have been considered together. The examiner considered claims 1-5 and 7-10 in the initial Office action and claims 1-10 in the Final Office action. Claims 6 and 11 should have been considered in each Office action. However, applicants state that because of the late stages of prosecution of this application entry of the amendment after Final Office action is more desirable. This amendment cancels claims 6 and 11 which were in question.

Applicants specifically request the entry of the amendment filed December 2, 2002, arguing that the amendment reduces the issues which may be before the Board of Patent Appeals and Interferences and places the claims in better form for appeal. The examiner's reason for not entering the amendment, as set forth in the Advisory Action, centers around the rejection under 35 U.S.C. 112, first paragraph, as not being overcome. However, this is not the criteria for entering/not entering an amendment. The question to be answered is whether the amendment reduces the issues or simplifies the claims in such a manner that the preparation of an Appeal Brief and/or examiner's answer is simplified. Normally cancellation of claims is sufficient to evidence simplification of the claims/issues on appeal. Further, the narrowing of claim 1, the only independent claim, by amendment, absent some additional error being introduced which would be grounds for rejection under 35 U.S.C. 112, second paragraph, is a clear evidence of simplification/reduction of issues. Further, the examiner has not pointed out why the amendment does not simplify the issues on appeal or does not present the claims in better form for appeal. In light of such lack of supportive reasoning, the amendment filed December 2, 2002, should have been entered by the examiner.

DECISION


For the reasons specified above, applicant's petition is **GRANTED** with respect to entry of the amendment filed December 2, 2002. The lack of unity question is considered moot in view of applicants cancellation of the affected claims.

Applicants remain under obligation to file an appropriate Appeal Brief or take other appropriate action within the time period set under 37 CFR 1.192(b).

The amendment filed December 2, 2002, will be entered.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

John Doll



Director, Technology Center 1600